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JARRETT, SCOTT L

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PAPER

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* HENRI JACQUES SUERMONDT,
9 GEORGE HENRY FORMAN, and
10 NINA MISHRA
11

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13 Appeal 2009-004386
14 Application 09/945,193
15 Technology Center 3600
16

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18 Decided: December 3, 2009
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21 Before HUBERT C. LORIN, ANTON W. FETTING, and BIBHU R.
22 MOHANTY, *Administrative Patent Judges*.
23 FETTING, *Administrative Patent Judge*.

24 DECISION ON APPEAL
25

1 STATEMENT OF THE CASE

2 Henri Jacques Suermondt, George Henry Forman, and Nina Mishra
3 (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of
4 claims 29, 30, 32-34, 36-42, 44-46, and 48-60, the only claims pending in
5 the application on appeal.

6 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
7 (2002).

8 SUMMARY OF DECISION¹

9 We AFFIRM-IN-PART and ENTER A NEW GROUND OF
10 REJECTION PURSUANT TO 37 C.F.R §41.50(b).

11 THE INVENTION

12 The Appellants invented a method and apparatus for predicting parts for
13 onsite repair (Specification 1:4-6).

14 An understanding of the invention can be derived from a reading of
15 exemplary claims 32, 38, 41, 42, and 58, which are reproduced below
16 [bracketed matter and some paragraphing added].

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed May 19, 2008) and Reply Brief ("Reply Br.," filed Sep. 9, 2008), and the Examiner's Answer ("Ans.," mailed July 9, 2008), and Final Rejection ("Final Rej.," mailed December 17, 2007).

1 32. A method executed by a computer, comprising:
2 [1] determining costs of mis-predicting parts that may be
3 replaced during an onsite repair of a product in response to a
4 repair history;
5 [2] selecting a subset of the parts to be sent to the onsite
6 repair in response to the costs; and
7 [3] identifying a set of symptoms associated with the
8 product, wherein determining the costs comprises determining a
9 cost of mis-predicting a subgroup of the parts according to
10 parameters indicating at least:

11 (1) a number of trips that the set of symptoms were
12 reported, the subgroup of parts were sent, and at least one
13 part not in the subgroup of parts was needed to complete
14 the onsite repair; and

15 (2) a number of trips that the set of symptoms were
16 reported, the subgroup of parts were sent, and the
17 subgroup of parts included at least one part that was
18 unnecessary in the onsite repair.

19

20 38. A method executed by a computer, comprising:
21 [1] determining costs of mis-predicting parts that may be
22 replaced during an onsite repair of a product in response to a
23 repair history, wherein the costs are computed based on
24 probabilities of over-predicting and under-predicting the parts;
25 [2] selecting a subset of the parts to be sent to the onsite
26 repair in response to the costs; and
27 [3] selecting another subset of the parts for training of call
28 qualifiers in response to the costs.

29

30 41. The method of claim 42, further comprising determining
31 which products are least desirable to support in response to the
32 costs.

33

34

1 42. A method executed by a computer, comprising:
2 [1] determining costs of mis-predicting parts that may be
3 replaced during an onsite repair of a product in response to a
4 repair history, wherein the costs are computed based on
5 probabilities of over-predicting and under-predicting the parts;
6 [2] selecting a subset of the parts to be sent to the onsite
7 repair in response to the costs; and
8 [3] determining which personnel to target for additional
9 training in response to the costs.

10

11 58. A method executed by a computer, comprising:
12 [1] determining costs of mis-predicting parts that may be
13 replaced during an onsite repair of a product in response to a
14 repair history, wherein the costs are computed based on
15 probabilities of over-predicting and under-predicting the parts;
16 and
17 [2] selecting a subset of the parts to be sent to the onsite
18 repair in response to the costs,
19 [3] wherein determining the costs of mis-predicting
20 comprises determining expected wastes for the corresponding
21 parts, wherein each expected waste is computed based on a
22 number of times the corresponding part was under-predicted, a
23 number of times the corresponding part was over-predicted, a
24 number of times the corresponding part was correctly predicted,
25 a cost of over-predicting the corresponding part, and a cost of
26 under-predicting the corresponding part, wherein the repair
27 history contains the number of times the corresponding part was
28 under-predicted, the number of times the corresponding part
29 was over-predicted, and the number of times the corresponding
30 part was correctly predicted.

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THE REJECTIONS

The Examiner relies upon the following prior art:

Glovitz et al. US 5,682,421 Oct. 28, 1997

Patton, Joseph D., Feldman, Herbert C., *Service Parts Handbook*, The Solomon Press Publishers, 1997 (“P&F”).

Patton, Joseph D. et al., *Service Management Principles and Practice*, Third Edition, ISA Press, 1994 (“Patton”).

Claims 29-30, 32-34, 36-42, and 55-60 stand rejected under 35 U.S.C. § 101 as being directed towards non-statutory subject matter.

Claims 29, 30, 33, 34, 36-40, 42, 44, 46, 48-52, and 54-60 stand rejected under 35 U.S.C. § 102 as anticipated by P&F².

Claims 32 and 45 stand rejected under 35 U.S.C. § 103(a) as unpatentable over P&F and Patton³.

Claims 41 and 53 stand rejected under 35 U.S.C. § 103(a) as unpatentable over P&F and Glovitz.

² The Appellants correctly note that the Examiner inadvertently failed to list claims 33, 34, 42, 44, and 46 under the 35 U.S.C. § 102(b) rejection (App. Br. 5).

³ The Appellants correctly note that claim 44 was incorrectly listed under the § 103(a) rejection and should have been listed under the § 102(b) rejection. (App. Br. 5).

ISSUES

- Whether the Appellants have sustained the burden of showing that the Examiner erred in rejecting claims 29-30, 34, 36-42, and 55-60 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter.
 - This pertinent issue turns on whether the claimed invention satisfies the machine-or-transformation test set forth in *Bilski*.
- Whether the Appellants have sustained the burden of showing that the Examiner erred in rejecting claims 29, 30, 33, 34, 36-40, 42, 44, 46, 48-52, and 54-60 under 35 U.S.C. § 102(b) as anticipated by P&F.
 - This pertinent issue turns on whether P&F describes the features of selecting a subset of parts to train personnel on based on costs, targeting personnel to train based on costs, and the repair history contains the number of times the corresponding part was under-predicted, the number of times the corresponding part was over-predicted, and the number of times the corresponding part was correctly predicted.
- Whether the Appellants have sustained the burden of showing that the Examiner erred in rejecting claims 32 and 45 stand 35 U.S.C. § 103(a) as unpatentable over P&F and Patton.
 - This pertinent issue turns on whether P&F and Patton describe limitations [3] (1) and [3] (2) of claim 32.

- Whether the Appellants have sustained the burden of showing that the Examiner erred in rejecting claims 41 and 53 under 35 U.S.C. § 103(a) as unpatentable over P&F and Glovitz.
 - This pertinent issue turns on whether the arguments in support of claims 42 and 44 were found persuasive.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to the Prior Art

P&F

01. P&F is directed to a discussion of service parts scheduling and management (P&F xix).
02. P&F describes that service parts demand are probabilistic and are driven by equipment failure plus human intervention (P&F 35). Forecasting the future demand requires knowledge of historical data and sharing knowledge between service parts managers, engineering, and marketing (P&F 35).
03. Stocking replacement parts in multiple locations typically means increased part quantities and costs, and an increased difficulty in finding the part you want that might not be where it is suppose to be (P&F 37). As such, it is vital to control inventory by location and quantity (P&F 37). Furthermore, it is essential to monitor the holding of parts and the actual use of parts (P&F 38).

1 Forecasting should include specific probabilities and confidence
2 levels (P&F 77). Planning should decide for each part what the
3 penalty of stocking-out is, and trade that against the cost of
4 carrying the safety stock (P&F 77).

5 04. The primary goal of parts is for personnel to have access to
6 parts that fill 85% of their parts needs within 15 minutes and the
7 remaining parts should be supplied overnight (P&F 59). The
8 authorized stock list (ASL) is a set of parts that should be stocked
9 at a specific location (P&F 59). The list is set to fill a high
10 percentage of demand and to balance that fill rate with desired
11 response time and cost (P&F 59).

12 05. A high first pass fix rate, completing repairs on a first service
13 visit, requires knowing which equipment is defective, diagnosing
14 to the problem component, recognizing the probable defective
15 parts, identifying the correct replacement parts, and supplying
16 those goods to the point of need (P&F 252-253). Deficiencies in
17 diagnostics, training, discipline, quality, and confidence results in
18 the ordering of parts not necessary to the repair (P&F 258).
19 Repair kits should be monitored by the field engineer and
20 management to determine which parts in the kits are in excess and
21 can be removed and which parts are needed and should be added
22 to the kit (P&F 73-74 and 165).

23 06. P&F further describes that service parts personnel need to be
24 trained (P&F 39 and 395). All parts people should be educated
25 about the service parts business, and about mathematics and how

1 to use basic economics and statistics that are necessary to
2 understand supply and demand (P&F 39). Training costs per
3 product unit should be monitored for parts and the cost of training
4 to sustain end of life products should be monitored (P&F 184).

5 *Patton*

6 07. Patton is also directed to a discussion service parts scheduling
7 and management (P&F xiii-xvi).

8 08. Patton describes human performance measurements, including
9 first call fix rate which is the quantity satisfied by the first visit,
10 the call back rate which is the number of attempts or visits to
11 complete a repair, and an attempts per incident ratio which is a
12 ratio of the total number of attempts to the total number of
13 incidences (Patton 48). A callback is a service call caused by the
14 inadequacy of an original service call (Patton 50).

15 *Glovitz*

16 09. Glovitz is directed to methods and apparatus for implementing
17 an automated dispatch service system, more particularly a system
18 which permits field technicians to interface with a central
19 computer via conventional telephone systems (Glovitz 1:11-15).

20 *Facts Related To The Level Of Skill In The Art*

21 10. Neither the Examiner nor the Appellants have addressed the
22 level of ordinary skill in the pertinent arts of operations research
23 and maintenance scheduling. We will therefore consider the cited
24 prior art as representative of the level of ordinary skill in the art.

1 *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001)
2 (“[T]he absence of specific findings on the level of skill in the art
3 does not give rise to reversible error ‘where the prior art itself
4 reflects an appropriate level and a need for testimony is not
5 shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys.*
6 *Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985).

7 *Facts Related To Secondary Considerations*

8 11. There is no evidence on record of secondary considerations of
9 non-obviousness for our consideration.

10 PRINCIPLES OF LAW

11 *101 - Bilski*

12 The law in the area of patent-eligible subject matter for process claims
13 has recently been clarified by the Federal Circuit in, *In re Bilski*, 545 F.3d
14 943 (Fed. Cir. 2008) (en banc), *petition for cert. filed*, 77 USLW 3442 (U.S.
15 Jan. 28, 2009) (No. 08-964).

16 The en banc court in *Bilski* held that “the machine-or-transformation test,
17 properly applied, is the governing test for determining patent eligibility of a
18 process under § 101.” *Id.* at 956. The court in *Bilski* further held that “the
19 ‘useful, concrete and tangible result’ inquiry is inadequate [to determine
20 whether a claim is patent-eligible under § 101.]” *Id.* at 959-60.

21 The court explained the machine-or-transformation test as follows: “A
22 claimed process is surely patent-eligible under § 101 if: (1) it is tied to a
23 particular machine or apparatus, or (2) it transforms a particular article into a
24 different state or thing.” *Id.* at 954 (citations omitted). The court explained

1 that “the use of a specific machine or transformation of an article must
2 impose meaningful limits on the claim’s scope to impart patent-eligibility”
3 and “the involvement of the machine or transformation in the claimed
4 process must not merely be insignificant extra-solution activity.” *Id.* at 961-
5 62 (citations omitted).

6 The court declined to decide under the machine implementation branch
7 of the inquiry whether or when recitation of a computer suffices to tie a
8 process claim to a particular machine. *Id.* at 962. As to the transformation
9 branch of the inquiry, however, the court explained that transformation of a
10 particular article into a different state or thing “must be central to the
11 purpose of the claimed process.” *Id.* at 962. As to the meaning of “article,”
12 the court explained that chemical or physical transformation of physical
13 objects or substances is patent-eligible under § 101. *Id.* at 962. The court
14 also explained that transformation of data is sufficient to render a process
15 patent-eligible if the data represents physical and tangible objects, *i.e.*,
16 transformation of such raw data into a particular visual depiction of a
17 physical object on a display. *Id.* at 962-63. The court further noted that
18 transformation of data is insufficient to render a process patent-eligible if the
19 data does not specify any particular type or nature of data and does not
20 specify how or where the data was obtained or what the data represented. *Id.*
21 at 962 (citing *In re Abele*, 684 F.2d 902, 909 (CCPA 1982) (process claim of
22 graphically displaying variances of data from average values is not patent-
23 eligible) and *In re Meyer*, 688 F.2d 789, 792-93 (CCPA 1982) (process
24 claim involving undefined “complex system” and indeterminate “factors”
25 drawn from unspecified “testing” is not patent-eligible)).

26

1 *Anticipation*

2 "A claim is anticipated only if each and every element as set forth in the
3 claim is found, either expressly or inherently described, in a single prior art
4 reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,
5 631 (Fed. Cir. 1987). "When a claim covers several structures or
6 compositions, either generically or as alternatives, the claim is deemed
7 anticipated if any of the structures or compositions within the scope of the
8 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.
9 Cir. 2001). "The identical invention must be shown in as complete detail as
10 is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d
11 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by
12 the claim, but this is not an *ipsissimis verbis* test, *i.e.*, identity of terminology
13 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

14 *Obviousness*

15 A claimed invention is unpatentable if the differences between it and
16 the prior art are "such that the subject matter as a whole would have been
17 obvious at the time the invention was made to a person having ordinary skill
18 in the art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham*
19 *v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

20 In *Graham*, the Court held that that the obviousness analysis is
21 bottomed on several basic factual inquiries: "[(1)] the scope and content of
22 the prior art are to be determined; [(2)] differences between the prior art and
23 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill
24 in the pertinent art resolved." *Graham*, 383 U.S. at 17. *See also KSR*, 550
25 U.S. at 406. "The combination of familiar elements according to known

1 methods is likely to be obvious when it does no more than yield predictable
2 results.” *Id.* at 416.

3 ANALYSIS

4 *Claims 29-30, 32-34, 36-42, and 55-60 rejected under 35 U.S.C. § 101*
5 *as being directed towards non-statutory subject matter*

6 The Examiner found that claims 29-30, 34, 36-42, and 55-60 fail to
7 satisfy machine-or-transformation test set forth in *Bilski*. Ans. 3-5. The
8 Examiner further found that the recitation of the method being executed by a
9 machine in the preamble was a nominal recitation of structure and therefore
10 did not recite statutory process. Ans. 4-5. The Appellants contend that the
11 subject matter in the claimed invention parallels that of the invention
12 claimed in *State Street* and therefore produces a useful, concrete, and
13 tangible result. Reply Br. 1-4. The Appellants also contend that the
14 language in the preamble cannot be ignored because it specifically defines
15 that the method has to be performed by a computer. Reply Br. 3.

16 We disagree with the Appellants. The Appellants contend that the
17 claimed invention satisfies both prongs of the machine-or-transformation
18 test and as such we will deal with each prong individually. First, the
19 claimed invention fails to transform an article into a different state or thing.
20 Claim 42 recites a method that involves at most the transformation of data
21 from stored historical data to cost indicating values, using probabilities. A
22 transformation of data is sufficient to render a process patent-eligible if the
23 data represents physical and tangible objects. The data in the claimed
24 invention only represents abstract values and does not represent physical and
25 tangible objects. Independent claims 38 and 58 recite the same

1 transformation of data and fail the transformation test for the same reasons
2 as claim 42. Dependant claims 29-30, 34, 36-37, 39-41, 55-57, and 59-60
3 fail to further recite any transformation of an article into a different state or
4 thing and therefore fail the transformation test for the same reasons as claims
5 38, 42, and 58. As such, the claims 29-30, 34, 36-42, and 55-60 fail to
6 satisfy the transformation prong of the machine-or-transformation test.

7 The machine prong of the *Bilski* machine-or-transformation test is
8 satisfied by showing that a claimed process is “tied to a particular machine.”
9 *Bilski*, 545 F.3d at 954. The claimed invention merely recites “a method
10 executed by a computer” in the preamble and we find that this recitation to
11 be insufficient to satisfy the machine test. The remaining body of the claim
12 fails to recite any further structure and as such the recitation of “a method
13 executed by a computer” in the preamble is merely a nominal recitation of
14 structure. Although this phrase ties the claimed process to a computer per
15 se, it does not tie the process to any particular computer or particular
16 machine. By this phrase, the claim covers tying the process to any general-
17 purpose computer. Independent claims 38 and 58 recite “a method executed
18 by a computer” and fail to satisfy the machine test for the same reasons as
19 claim 42. Dependant claims 29-30, 34, 36-37, 39-41, 55-57, and 59-60 fail
20 to further recite any particular machine or apparatus and therefore fail the
21 machine test for the same reasons as claims 38, 42, and 58. As such, the
22 claims 29-30, 34, 36-42, and 55-60 fail to satisfy the machine prong of the
23 machine-or-transformation test.

24 The Appellants have not sustained the burden of showing that the
25 Examiner erred in rejecting claims 29-30, 34, 36-42, and 55-60 under 35
26 U.S.C. § 101 as being directed towards non-statutory subject matter.

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NEW GROUND OF REJECTION

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The following new ground of rejection is entered pursuant to 37 C.F.R. § 41.50(b). Claims 32 and 33 are rejected under 35 U.S.C. § 101 as being directed towards non-statutory subject matter.

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Claim 32 also recites a “method executed by a computer.” This method fails to satisfy the machine-or-transformation test as set forth by *Bilski* for the same reasons discussed *supra* for claims 29-30, 34, 36-42, and 55-60.

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Claim 33 is dependant on independent claim 42, which was found to be directed towards non-statutory subject matter *supra*. Claim 33 fails to cure the deficiencies in claim 42 and as such is rejected for being directed towards non-statutory subject matter for the same reasons discussed *supra* for claim 42.

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Claims 29, 30, 33, 34, 36-40, 42, 44, 46, 48-52, and 54-60 stand rejected under 35 U.S.C. § 102 as anticipated by P&F

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The Appellants contend that (1) P&F fails to describe selecting another subset of the parts for training of call qualifiers in response to the costs, as required by claim 38 (App. Br. 9-11 and Reply Br. 5-7) and that (2) P&F fails to describe determining which personnel to target for additional training in response to the costs, as required by claim 42 (App. Br. 9-11 and Reply Br. 7). We agree with the Appellants. P&F describes the general need for service repair personnel training. FF 06. P&F further describes personnel training costs per unit, as it relates to the end of a product life cycle. FF 06.

1 However, P&F fails to specifically correlate training and costs as they relate
2 to a subset of parts (as required by claim 38) and as they relate to
3 determining which personnel to target for the training (as required by claim
4 42).

5 The Examiner has provided numerous citations to portions of P&F that
6 describe general training concepts, but has failed to articulate how these
7 cited portions of P&F anticipate claims 38 and 42. The Examiner first cites
8 to P&F pages 45-46 which describe using data on supply and demand to
9 guide improvements in training for generally reducing the number of parts
10 used and lower costs (Ans. 47), but this description fails to specifically
11 describe selecting a subset of parts for training personnel on based on the
12 costs and targeting specific personnel to train based on costs.

13 The Examiner further cites to P&F page 444 which describes how poor
14 technician diagnostic skills can result in the ordering of extra and unneeded
15 parts (Ans. 47), however, this portion of P&F is completely silent on any
16 aspect of training personnel for a subset of parts based on cost or targeting
17 personnel for training based on costs. The Examiner further cites to P&F
18 pages 39, 395, 396, and figure 25-2 which describe the need to train parts
19 personnel on supply and demand principles and how to set forth specific
20 training for parts personnel, but these descriptions fail to incorporate any of
21 the cost reducing measures for inventory management required by the
22 claimed invention. The Examiner further cites to Patton to describe these
23 limitations, however, the anticipation rejection set forth by the Examiner
24 does not rely on Patton.

1 The Appellants further contend that (3) P&F fails to describe the number
2 of times the corresponding part was under-predicted, the number of times
3 the corresponding part was over-predicted, and the number of times the
4 corresponding part was correctly predicted, which are all part of the repair
5 history, as required by claim 58. App. Br. 11. We agree with the
6 Appellants. P&F describes the costs of over-predicting and under-predicting
7 inventory amounts for service parts. FF 03 and FF 04. However, P&F fails
8 to specifically describe the number of times parts were under-predicted and
9 over-predicted. P&F further fails to describe that all of this information can
10 be found in a repair history. The Examiner has again provided numerous
11 citations in P&F in the rejection, but fails to provide any rationale as to how
12 these descriptions in P&F anticipate claim 58 in the rejection and in
13 response to arguments.

14 The Appellants additionally contend that (4) claim 54 depends from
15 claim 44 and is therefore allowable for the same reasons. App. Br. 12. We
16 agree with the Appellants. P&F fails to describe the limitations of claim 44
17 for the reasons set forth *supra* in the discussion of claim 58. As such, P&F
18 fails to describe claim 44 for the same reasons.

19 The Appellants have sustained the burden of showing that the Examiner
20 erred in rejecting claims 29, 30, 33, 34, 36-40, 42, 44, 46, 48-52, and 54-60
21 under 35 U.S.C. § 102(b) as anticipated by P&F.

*Claims 32 and 45 rejected under 35 U.S.C. § 103(a) as unpatentable
over P&F and Patton*

The Appellants contend that P&F and Patton fail to describe limitations [3] (1) and [3] (2) of claim 38. App. Br. 5-8. We disagree with the Appellants. Limitation [3] (1) requires that determining the costs of mis-predicting parts when the mis-prediction occurs when a number of trips for a set of symptoms is reported, the subgroup of parts is sent, and at least one part not in the subgroup was needed to complete the repair. Limitation [3] (2) further requires determining the cost of mis-predicting parts when the mis-prediction occurs when a number of trips for a set of symptoms is reported, the subgroup of parts is sent, and at least one part not in the subgroup was unnecessary to complete the repair.

P&F describes monitoring the costs of mis-predicting parts. FF 04 and FF 05. P&F further describes the use of kits for service calls with similar symptoms. FF 05. The kits should be further refined to remove components that are not needed for repairs and to add components that are not included in the kits but are commonly needed. FF 05. That is, costs for carrying unnecessary parts and costs for not having necessary parts are accounted for. P&F, as noted by the Examiner, fails to describe a number of trips. Ans. 32. Patton describes measuring performance that includes a callback rate and a number of attempts per incident. FF 08. A callback is a service visit to a repair site when the original service visit was unsuccessful in completing a repair. FF 08. That is, a callback is another trip and the number of callbacks includes a value for the number of trips required for a single repair. As such, Patton describes a number of trips and the combination of P&F and Patton describes limitations [3](1) and [3](2) of claims 32 and 45.

1 The Appellants have not sustained the burden of showing that the
2 Examiner erred in rejecting claims 32 and 45 stand 35 U.S.C. § 103(a) as
3 unpatentable over P&F and Patton.

4
5 *Claims 41 and 53 under 35 U.S.C. § 103(a) as unpatentable over P&F*
6 *and Glovitz*

7 The Appellants contend that claims 41 and 53 are allowable for the same
8 reasons set forth for claims 42 and 44. App. Br. 12. We agree with the
9 Appellants. Claims 41 and 53 depend from claims 42 and 44 and therefore
10 the Appellants arguments in support of claims 42 and 44 *supra* are found
11 persuasive for claims 41 and 53 here.

12 The Appellants have sustained the burden of showing that the Examiner
13 erred in rejecting claims 41 and 53 stand 35 U.S.C. § 103(a) as unpatentable
14 over P&F and Glovitz.

15
16 CONCLUSIONS OF LAW

17 The Appellants have not sustained the burden of showing that the
18 Examiner erred in rejecting claims 29-30, 34, 36-42, and 55-60 under 35
19 U.S.C. § 101 as being directed towards non-statutory subject matter.

20 A new ground of rejection is entered 37 C.F.R. § 41.50(b) in which
21 claims 32 and 33 are rejected under 35 U.S.C. § 101 as directed towards
22 non-statutory subject matter.

1 The Appellants have sustained the burden of showing that the Examiner
2 erred in rejecting claims 29, 30, 33, 34, 36-40, 42, 44, 46, 48-52, and 54-60
3 under 35 U.S.C. § 102(b) as anticipated by P&F.

4 The Appellants have not sustained the burden of showing that the
5 Examiner erred in rejecting claims 32 and 45 under 35 U.S.C. § 103(a) as
6 unpatentable over P&F and Patton.

7 The Appellants have sustained the burden of showing that the Examiner
8 erred in rejecting claims 41 and 53 under 35 U.S.C. § 103(a) as unpatentable
9 over P&F and Glovitz.

10
11 DECISION

12 To summarize, our decision is as follows.

- 13 • The rejection of claims 29-30, 34, 36-42, and 55-60 under 35 U.S.C. §
14 101 as being directed towards non-statutory subject matter is
15 sustained.
- 16 • A new ground of rejection is entered pursuant to 37 C.F.R. § 41.50(b).
 - 17 ○ Claims 32 and 33 are rejected under 35 U.S.C. § 101 as being
18 directed towards non-statutory subject matter.
- 19 • The rejection of claims 29, 30, 33, 34, 36-40, 42, 44, 46, 48-52, and
20 54-60 under 35 U.S.C. § 102(b) as anticipated by P&F is not
21 sustained.
- 22 • The rejection of claims 32 and 45 stand 35 U.S.C. § 103(a) as
23 unpatentable over P&F and Patton is sustained.

- 1 • The rejection of claims 41 and 53 stand 35 U.S.C. § 103(a) as
2 unpatentable over P&F and Glovitz is not sustained.

3

4 Our decision is not a final agency action.

5 In addition to affirming the Examiner's rejection(s) of one or more
6 claims, this decision contains new grounds of rejection pursuant to 37 C.F.R.
7 § 41.50(b). 37 CFR § 41.50(b) provides “[a] new ground of rejection
8 pursuant to this paragraph shall not be considered final for judicial review.”

9 This Decision contains a new rejection within the meaning of 37
10 C.F.R. § 41.50(b) (2007).

11 37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO
12 MONTHS FROM THE DATE OF THE DECISION, must exercise one of
13 the following two options with respect to the new rejection:

14 (1) Reopen prosecution. Submit an appropriate amendment of
15 the claims so rejected or new evidence relating to the claims
16 so rejected, or both, and have the matter reconsidered by the
17 Examiner, in which event the proceeding will be remanded
18 to the Examiner. . . .

19 (2) Request rehearing. Request that the proceeding be reheard
20 under § 41.52 by the Board upon the same record. . . .

21 Should the Appellants elect to prosecute further before the examiner
22 pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek
23 review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection,
24 the effective date of the affirmance is deferred until conclusion of the

1 prosecution before the Examiner unless, as a mere incident to the limited
2 prosecution, the affirmed rejection is overcome.

3 If the Appellants elect prosecution before the Examiner and this does
4 not result in allowance of the application, abandonment or a second appeal,
5 this case should be returned to the Board of Patent Appeals and Interferences
6 for final action on the affirmed rejection, including any timely request for
7 rehearing thereof.

8 No time period for taking any subsequent action in connection with this
9 appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
10 § 1.136(a)(1)(iv) (2007).

11
12 AFFIRMED-IN-PART

13 41.50(b)

14
15
16
17 mev

18
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23